

IN THE DRAWINGS:

In a Submission of Replacement Drawings filed concurrently herewith, Applicants respectfully request to amend Fig. 3 (1 sheet) to show the features of the invention specified in the claims and the convention names as described in the specification.

REMARKS**Summary of the Office Action**

In the Office Action, the drawings were objected to as failing to show the conventional names as described in the specification.

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,525,511 to *Kubale et al.* ("Kubale") in view of disclosed Prior Art, JP-09285006 ("JP'006").

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kubale* in view of *JP'006* and further in view of U.S. Patent No. 6,373,152 to *Wang et al.* ("Wang").

Summary of the Response to the Office Action

Applicants have amended claims 1-2, 4-5, and added new claim 7. Accordingly, claims 1-7 are pending for further consideration.

Objection to the Drawings

The drawings were objected to as failing to show the conventional names as described in the specification. Applicants concurrently file a Submission of Formal Drawings with one (1) sheet of formal drawings to substitute the original filed drawing sheet. The new formal drawings amend Fig. 3 to show the features of the invention specified in the claims and the conventional names as described in the specification. Applicants respectfully request that the objection to the drawings be removed.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kubale* in view of *JP'006*. Applicants respectfully traverse the rejection for the following reasons.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicants are under “no obligation to submit evidence of nonobviousness,” such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicants.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Applicants respectfully submit that newly amended independent claim 1 includes the features of “safety switch and the trigger switch are off, the plurality of electrical double layer capacitors are connected in parallel, . . . [the] safety switch is turned on, the plurality of electric double layer capacitors are connected in series,” and similarly independent claim 4 includes the features of “a series parallel switching circuit that switches the plurality of electric double layer capacitors into parallel connection when a start switch is off, and switches the plurality of electric double layer capacitors into series connection when the start switch is on.” At least the

above features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Kubale* or *JP'006*.

Kubale shows an adapter for a power tool battery that enables a battery having a first configuration, such as a slide-on configuration, to be used with a power tool to be charged by a battery charger having a second configuration such as a “tower” configuration. See the Abstract of *Kubale*.

JP'006 discloses an electric heating catalyst placed in the exhaust system of an engine, capacitors are arranged in parallel for charging when switches are in the open position, but are arranged in series for discharging when the switches are in the closed position so that large electric power may be supplied to the electric heating catalyst. See the translated Abstract of *JP'006*.

First, the Office Action does not establish a *prima facie* case of obviousness at least because it has not identified any suggestion or motivation to combine the cited reference teachings. The *JP'006* reference is a document relating to a heater of a catalyst in an exhaust device of an automobile. Therefore, *JP'006* is a complete non-analog to the present invention's electric hand tool, and the rejection based on *JP'006* is improper. See the Abstract of *JP'006*.

As such, the suggestion or motivation to combine is not provided by either the references themselves or by knowledge generally available to one of ordinary skill in the art. Therefore, it is respectfully submitted that the statement in the Office Action is not sufficient by itself to meet the first prong of *prima facie* obviousness. In fact, the MPEP § 2143.01 states that “the level of skill in the art cannot be relied upon to provide the suggestion to combine references.” *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to the references of record that shows the desirability of combining *Kubale* and *JP'006*. The mere assertion that *Kubale* and *JP'006* could be combined is not sufficient by itself to establish *prima facie* obviousness. Therefore, it is respectfully submitted that the Office Action has not met the second prong of *prima facie* obviousness.

Third, the Office Action has not established a *prima facie* case of obviousness at least because neither *Kubale* nor *JP'006*, whether alone or in combination, teach or suggest all the recited features of independent claims 1 and 4. Namely, neither *Kubale* nor *JP'006* teach or suggest at least the above-recited features.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Kubale* and *JP'006* do not teach or suggest each and every feature of independent claims 1 and 4.

Additionally, Applicants respectfully submit that dependent claims 2 and 5 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 4, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kubale* in view of *JP'006* and further in view of *Wang*. Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Applicants respectfully submit that newly amended independent claim 1 includes the features of “a trigger lever; and a trigger switch,” and independent claim 4 includes the features of “a series parallel switching circuit that switches the plurality of electric double layer capacitors into parallel connection when a start switch is off, and switches the plurality of electric double layer capacitors into series connection when the start switch is on.” At least the above features are absent from, and are neither disclosed nor taught, alone or in combination, by *Kubale*, *JP'006*, and *Wang*.

Wang shows an electrical energy storage device. See the Abstract of *Wang*.

The Office Action has not established a *prima facie* case of obviousness at least because *Kubale*, *JP'006*, and *Wang* whether alone or in combination, do not teach or suggest all the recited features of independent claims 1 and 4. Namely, since *Kubale*, *JP'006* and *Wang* do not disclose a “contact arm,” a “trigger lever,” and a “trigger switch” of the amended claim 1 and new claim 7.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Kubale*, *JP'006*, and *Wang* do not teach or suggest each and every feature of independent claims 1 and 4.

Additionally, Applicants respectfully submit that dependent claims 2-3 and 5-6 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 4, as well as reciting additional features that further distinguish over the applied prior art.

Applicants respectfully submit that independent claim 7 is also allowable for the reasons above-mentioned.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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